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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,725	12/15/2000	Bryan R. Goring	NTL-3.2.141/3504(11726STU	1456
35437	7590	01/25/2006		
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO 666 THIRD AVENUE NEW YORK, NY 10017			EXAMINER RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/738,725

Applicant(s)

GORING, BRYAN R.

Examiner

Yehdega Retta

Art Unit

3622

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed November 04, 2005.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 19-23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts (US 6,493,110).

Regarding claims 1, 3, 4, 6, 10, 19 and 21 Roberts teaches downloading transaction information (downloaded advertisement with a barcode, that includes transaction data such as redemption amount, expiration or term of offer; identity of coupon holder, issuer, etc (see col. 6 line 64 to col. 7 line 15, col. 18 lines 44-63); downloading the image from a remote location (see fig. 1 personal computer) retrieving an image associated with the transaction information (see

Art Unit: 3622

fig. 5, col. 7 lines 16-28); converting the image into a pixels matrix representations and printing at least one scan line corresponding to pixel matrix or converting the image into gray scale or dithered black and white pixel matrix (see col. 7 lines 30-40col. 18 line 63 to col. 19 lines 30, col. 19 line 60 to col. 20 line 31).

Regarding claim 2, Roberts teaches wherein the transaction information includes image information (see abstract and col. 12 lines 41-49).

Regarding claims 5, 7 and 8, wherein the image information is a file name or a URL (see col. 11 lines 49-62).

Regarding claim 9, Roberts teaches wherein the scan line is printed in a predetermined location on a receipt (see col. 19 line 61 to col. 22 line 10).

Regarding claim 20, Roberts teaches the network includes the Internet (see fig. 1).

Regarding claims 22 and 23, Roberts teaches the workstation includes a kiosk or Point-of-sale (POS) terminal (see col. 5 lines 45-67).

Regarding claim 25, Roberts teaches downloading image information from a database; retrieving an image associated with the image information (see fig. 5, col. 7 lines 16-28, col. 6 line 64 to col. 7 line 15, col. 18 lines 44-63); converting the image into grayscale; converting the grayscale image into dithered black-and-white pixels; converting the dithered pixels into pixel matrix representation and printing at least one scan line by selecting printing pixels corresponding to the pixel representation (see col. 7 lines 30-40col. 18 line 63 to col. 19 lines 30, col. 19 line 60 to col. 20 line 31).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 6,493,110) in view of Kanevsky et al. (US 6,334,109).

Regarding claims 10-13, and 15, Roberts teaches downloading transaction information (downloaded advertisement with a barcode, that includes transaction data such as redemption amount, expiration or term of offer; identity of coupon holder, issuer, etc (see col. 6 line 64 to col. 7 line 15, col. 18 lines 44-63); downloading the image from a remote location (see fig. 1 personal computer) retrieving an image associated with the transaction information (see fig. 5, col. 7 lines 16-28); converting the image into a pixels matrix representations and printing at least one scan line; converting the image into pixels matrix representation and printing pixels corresponding to pixel matrix or converting the image into gray scale or dithered black and white pixel matrix (see col. 7 lines 30-40, col. 18 line 63 to col. 19 lines 30, col. 19 line 60 to col. 20 line 31). Roberts does not teach monitoring transaction information, comparing the information to a database. Kanevsky teaches monitoring user transaction and comparing the transaction to an advertisement database and downloading advertisement information from the database responsive to the match and printing the downloaded advertisement on a receipt or coupon (see col. 5 lines 18-57, col. 7 lines 53 to col. 8 line 33). Kanevsky teaches retrieving advertisement associated with the transacting and printing the advertisement (see col. 5 line 18-57). Kanevsky

Art Unit: 3622

teaches the transaction information including advertisement information (see col. 2 lines 1-40, 60-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Kanevsky's personalized advertisement, by monitoring user's transaction history (past and present) for the intended use of providing advertisement personalized to a particular user and to present it at the point of sale by displaying it or printing on the sales terminal as taught by Kanevsky (see abstract).

Regarding claims 14, 16 and 17, wherein the image information is a file name or a URL (see col. 11 lines 49-62).

Regarding claim 18, Roberts teaches wherein the scan line is printed in a predetermined location on a receipt (see col. 19 line 61 to col. 22 line 10).

Regarding claim 26, Roberts does not teach monitoring transaction information, comparing the information to a database. Kanevsky teaches monitoring user transaction and comparing the transaction to an advertisement database and downloading advertisement information from the database responsive to the match and printing the downloaded advertisement on a receipt or coupon (see col. 5 lines 18-57, col. 7 lines 53 to col. 8 line 33). Kanevsky teaches retrieving advertisement associated with the transacting and printing the advertisement (see col. 5 line 18-57). Kanevsky teaches the transaction information including advertisement information (see col. 2 lines 1-40, 60-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Kanevsky's personalized advertisement, by monitoring user's transaction history (past and present) for the intended use of providing advertisement personalized to a particular user and to present it at the point of sale by displaying it or printing on the sales terminal as taught by Kanevsky (see abstract).

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al. (US 6,334,109) in view of Roberts (US 6,493,110).

Regarding claim 24, Kanevsky teaches a coupon generator to receive and process purchase information related to a transaction, providing at least one index pointer responsive to the purchase information an advertisement database having accessible coupon fields and the coupon generator incorporating a related coupon advertisement with said purchase information for transmission to an output port (see (see col. 5 lines 18-57, col. 7 lines 53 to col. 8 line 33). Kanevsky does not teach coupon image, it is taught in Roberts. It would have been obvious to one of ordinary skill in the art at the time of the invention to include Roberts' coupon in Kanevsky personalized advertisement for the intended use of providing users with coupon that can be redeemed at a retail/checkout as taught in Roberts.

#### ***Response to Arguments***

Applicant's arguments, see, filed November 4, 2005, with respect to the rejection(s) of claim(s) 1-26 under USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Roberts and Kanevsky.

#### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

  
**RETTA YEFDEGA**  
**PRIMARY EXAMINER**